

## REMARKS

Reconsideration of this application in view of the above amendments and the following remarks is respectfully requested.

### **I. Status of the Application**

Claims 1 – 89 are presently pending, with claims 1 – 14, 17 – 20 and 23 – 26 having previously been withdrawn due to a restriction requirement. Applicants amend claim 89. No new matter is introduced. Support for the amendment may be found, for example, with reference to Applicants' specification at page 27, line 1 through page 28, line 14 and page 28, line 21 through page 29, line 11.

A final Office Action was mailed on February 25, 2009, responsive to a Request for Continued Examination and Information Disclosure Statement (IDS) mailed on January 14, 2009.

Applicants earlier mailed IDSs on August 18, 2008 and October 7, 2008, during which time the application was docketed for appeal. Because the application was on appeal and Applicants could not make the required certifications under 37 C.F.R. § 1.97(d), Applicants expected to refile the IDSs of August 18, 2008 and October 7, 2008 upon the return of the application to prosecution, together with a Request for Continued Examination (RCE) and the required fees.

Upon information and belief, the application was remanded by the Board of Patent Appeals and Interferences (BPAI) prior to December 15, 2008. On December 15, 2008, an Office Communication was mailed indicating that the IDSs of August 18, 2008 and October 7, 2008 failed to meet the requirements of 37 C.F.R. § 1.97, and that the application would again be docketed for appeal. Upon information and belief, after December 15, 2008, the BPAI remanded the application, requiring that the IDSs be considered before continuing with the decision on appeal.

Upon information and belief, on or about January 13, 2009, Applicants' representative discussed the status of the application with the Examiner, at which time the Examiner suggested that the IDSs of August 18, 2008 and October 7, 2008 be filed together with a RCE so the IDSs could be considered and the application could be placed back on the appeal docket. Applicants filed the IDSs and RCE on January 14, 2009.

In accordance with MPEP § 706.07(h)(X), an RCE filed after appeal but before a decision by the BPAI will be normally be treated as a request to withdraw the appeal and reopen prosecution. Based on Applicants' representative's discussion with the Examiner on January 13, 2009, and with reference to 37 C.F.R. § 1.114 (c), Applicants believed that the RCE of January 14 would be considered to constitute a *proper* and *bona fide* response. However, upon further discussion with Ms. Magdalen Greenlief of the MPEP office on February 27, 2009, it was brought to Applicants' attention that, under MPEP § 706.07(h)(X), in order for an RCE filed after appeal but before a decision on appeal to be *proper* and responsive within the meaning of 37 C.F.R. § 1.111, it must in some way advance the prosecution by making further claim amendments and/or otherwise placing the application in condition for allowance. An *improper* RCE which does not otherwise constitute a *bona fide* attempt to provide a complete reply will be deemed to terminate proceedings. Under MPEP § 706.07(h)(X), no claims are allowed, the application will be deemed to be abandoned.

Applicants presume that the RCE of January 14 was deemed to be *proper*, as it resulted in the mailing of the final Office Action of February 25, 2009. If the RCE however constituted an incomplete reply, Applicants provide the present Amendment in Response to Final Office Action of February 25, 2009, which includes further claim amendment and arguments. Applicants submit that the present Amendment to the Office Action of February 25 is fully responsive.<sup>1</sup>

Applicants respectfully request that the Office confirm the current status of the present application in its next Office Communication.

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<sup>1</sup> Applicants note that the Office Action of February 25 is essentially identical to the previous final Office Action of December 11, 2006.

## **II. Special Status**

The present application has been granted special status (See, Decision on Petition to Make Special, mailed April 14, 2004). Accordingly, Appellants request accelerated treatment of this Response.

## **III. Rejections Under 35 U.S.C. § 103**

Claims 15, 16, 21, 22, 27 – 31, 33 – 35 and 37 - 89 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,076,443 to Emens et al. (“Emens”) in view of U.S. Patent No. 5,835,087 to Herz et al. (“Herz”). Claims 32 and 36 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Emens in view of Herz and the Examiner’s official notice. Applicants amend claim 89 to further clarify the nature of their invention, and respectfully traverse the rejections of claims 15, 16, 21, 22, 27 – 36 and 37 – 89 under 35 U.S.C. § 103(a).

In independent claim 15, Applicants claim:

**15.** A system for delivering ads to a user viewing content operating a station connected to a distributed computer network, comprising:

an ad server which maintains the ads for the user at the station across the distributed computer network, the user station allowing the user to retrieve information containing content;

a data store containing a set of relevancy rules associated with each ad, the rules being operable to indicate a level of relevancy of the ad to the content of the information retrieved; and

a match maker configured to, in response to the submission of a URL by the user at the operating station, access the content retrieved by the user, extract the content according to extracting rules, parse the content of the information into objects, target an ad from the server to the content by applying the relevancy rules in the data store to the objects, free of information about the user, and directly send the targeted ad to the station for display with the content.

The Examiner suggests that each of the elements of claim 15 is taught by Emens, with the exception of the feature providing that the match maker is configured to access the content retrieved by the user, extract the content according to extracting rules, parse the content of the information into objects, target an ad from the server to the content by applying the relevancy rules in the data store to the objects, free of information about the user, and directly send the targeted ad to the station for display with the content in response to the submission of a URL by the user at the operating station. The Examiner, however, suggests that this deficiency is overcome with the addition of Herz. Applicants respectfully disagree.

In a Second Brief on Appeal Under 37 C.F.R. § 41.37 filed on June 11, 2007, Applicants distinguished their invention as claimed over the cited references on the basis of the following three points:

**Point 1**

**Claim 15 recites that the requested content and associated advertising be displayed together. The effect of submitting the URL in the claimed invention is that an advertisement and the content at the URL are pulled to a user's work station for display together. Emens neither discloses nor suggests displaying the requested content and the targeted ad together.**

Indeed, Emens discloses that either (rather than both) the requested information or the ad be shown. Emens further makes it clear that the ad should be shown only if the user specifically asks for it:

The search engine then returns a specific search result set showing items which may contain the sought after information. For each search result item, a graphical user interface (GUI) selection is presented, **allowing the user to select the GUI, on demand if so desired, to investigate related advertisement.**

Emens, Col. 4, line 65 thru Col. 5, line 3 (emphasis added).

Emens, at Col. 7, lines 50-51, discloses that "advertisements can . . . be provided on the user's demand." Here Emens clearly distinguishes between an icon or link that is selected by a user, and an advertisement that is provided after the user makes a selection. Applicants submit

that all that Emens discloses displaying along with the search result is an icon or a link representing, or corresponding, to an ad, but not constituting an advertisement itself. Therefore, as noted above, Emens clearly fails to teach that the ads should be shown with the content. Because clicking on the displayed icon in Emens results in displaying the ad, Emens teaches that either the content or the ads should be shown, not both. Emens neither discloses nor suggests displaying the ad with the content retrieved by the user. This feature is also missing from Herz.

In the present Office Action, the Examiner makes reference to Col. 7, lines 11 – 18 of Emens:

The request server 160 then builds a results page which contains the search result items, and if the search result item was flagged as a having a product match, a product icon or graphical user interface designator is also displayed for subsequent user selection. The search result items and associated product icons are then displayed 98 to the browser 100

It is the Examiner's position that "[the] product icon is a targeted advertisement based on the search result." Applicants disagree. Simply stated, an icon is not an advertisement. Rather, it is "[a] picture on a screen that represents a specific file, directory, window, option, or program" (emphasis added).<sup>2</sup> Emens' icon as described does not directly provide information promoting a particular product or service<sup>3</sup> In fact, Emens icon is not even limited to representing a single advertisement, but merely provides an indication that one or more relevant ads have been identified for a particular query result. As described , for example, by Emens at Col. 7: 21 – 35, selection of the icon causes a listing of matching ads ("products") to be returned for display as a separate screen:

The request server 160 displays the results that the user will receive from the query, product matching, and results presentation pass. The user may either select from the search result set as before, or select a product icon corresponding to each search result item having at least one product advertisement associated with it in the search result set. If the user selects a search result item (not the product icon), he or she is ultimately shown the information pertaining to that item. However, if the user requests a product 95 by selecting the product icon, the user/session manager 120 routes the product request 95 to the product presentation or product listing manager 150.

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<sup>2</sup> <http://www.thefreedictionary.com/icon>

<sup>3</sup> An advertisement is "[a] notice, such as a poster or a paid announcement in the print, broadcast, or electronic media, designed to attract public attention or patronage." <http://www.thefreedictionary.com/advertisement>.

The product presentation manager 150 then references the products in the Product Database 110. Products which match this search result item are then formulated into one list and passed to the request server or results presentation manager 160.

(Emphasis added).

## **Point 2**

**The Examiner contends that it would be obvious to use a URL to obtain the content in view of Herz. However, as Emens clearly teaches away from Herz, one skilled in the art at the time of the present invention would have no reason to combine Emens with Herz in the manner suggested by the Examiner.**

Applicants note that Herz makes no explicit reference to a uniform resource locator, or “URL.” At step 1102 of Fig. 10, Herz teaches that a user may make a request to retrieve news articles after logging into a network and activating a news reading program. The Examiner suggests that this step is equivalent to the “submission of a URL” as claimed by Applicants.

Even assuming *arguendo* that Herz can be read to suggest submitting a URL in order to access the news reading program, one skilled in the art at the time of the present invention would have little reason to look to Herz for the purpose of modifying the teachings of Emens.

Emens teaches that prior art systems (such as Herz) rely on user profiles to select advertising, and that such systems are disadvantageous because, *inter alia*, they require continuous updating (see, e.g. Emens at Col. 1: 29 – 63). Instead of using user profiles to indentify target advertisements, Emens teaches using search result items from a search engine performing an Internet search to provide information for selecting targeted ads (see, e.g., Emens at Col. 4: 54-58.) In this regard, search results provide the advantage of including summary (abstract) information from which key words can be readily identified for matching among the target advertisements (see, e.g., Emens at Col. 5: 20 – 43). As submitting URLs on the basis of Herz would result in a loss of the benefits provided by using search results in the manner taught by Emens, one of skill in the art at the time of the present invention would have had no incentive to combine the references in the manner suggested by the Examiner.

The Examiner argues presently that “modifying Emens to incorporate [Herz’s] teachings will produce a system wherein the user uses a URL instead of keywords to retrieve the

content.” However, Applicants submit that Herz teaches using a URL to access a program for the purpose of retrieving ads (“news articles”) that have been preselected based on the user’s stored profile data, and not as a source of keywords for retrieving relevant ads. Thus, Herz clearly teaches away from the approach of Emens.

### **Point 3**

#### **Combining Emens and Herz does not result in the claimed invention.**

If taken together, Emens and Herz must teach either (1) executing a URL to reach a search engine that accepts a user’s query to search the Internet, with the results being sent to a product matching manager for determining whether one or more advertisements (“products”) match each result and for delivering an icon in association with each search result that has at least one match (as required by Emens’ system); or (2) determining the relevancy of an advertisement (“news article”) based on a comparison of the content of the ad to a user’s profile, and preparing a list of relevant ads to be sent to the user for possible reading (as required by Herz’s disclosure). In the latter case, the list is sent separately without being incorporated in content that the user has actively retrieved. In order to see the associated ads (“news stories”), the user must navigate to the system website to download them.

Unlike Applicants’ claimed invention, neither of these two scenarios provides a system or method for displaying an advertisement on a web page that the user has summoned by merely providing a URL of the web page and no further information about the user. More specifically, Applicants submit that the combination of Emens and Herz does not teach or suggest Applicants’ claimed match maker that parses the content of a web page associated with the URL to identify objects, applies relevancy rules to the identified objects in order to identify a targeted ad, and displays the targeted ad together with the contents of the web page on a user’s display.

For at least the above-argued reasons, Applicants submit that independent claim 15 is not made obvious by the combination of Emens and Herz, and stands in condition for allowance. As independent claims 21 and 89 include essentially the same elements argued above as distinguishing independent claim 15 over the cited references, Applicants submit that independent claims 21 and 89 are also allowable for at least the same reasons. As claims 16, 22,

and 27 – 88 each depend either directly or indirectly from one of allowable claims 15 and 21, Applicants submit that dependent claims 16, 22 and 27 – 88 are allowable for at least this reason.

Applicants further submit that amended independent claim 89 is allowable on additional grounds.

In amended independent claim 89, Applicants claim:

**89.** A system for delivering ads to a user operating a station connected to a computer network, to retrieve and view information containing content comprising:

a server for storing the ads for delivery to the user operating the station connected to the computer network;

a memory containing a set of relevancy rules associated with an ad, said relevancy rules being operable to indicate a level of relevancy of the ad to the content of the information; and

a module configured to, in response to the submission of a URL by the user at the operating station, access the information retrieved by the user as a result of submitting the URL, extract the content from the information based on extracting rules, parse the content into objects and corresponding attributes, group objects with associated attributes, target an ad to the content by applying the relevancy rules in the memory to the grouped objects and attributes, free of information about the user, and directly send the targeted ad to the station for simultaneous display with the content.

(Emphasis added)

Amended independent claim 89 adds that the content (i.e., web page) associated with the URL is parsed to identify and group objects and their associated attributes, and that relevancy rules are applied to the grouped objects and attributes in order to identify the targeted ads. Applicants submit that neither Emens nor Herz teaches or suggests parsing a web page to obtain groupings of objects and attributes to be used in the selection of relevant ads.

Applicants also submit that dependent claims 32 and 36 are allowable on additional grounds. The Examiner contends that Emens and Herz disclose most of the features of claims 32 and 36. However, the Examiner acknowledges that Emens and Herz do not disclose that performance is measured by a change in revenues or click-through rates (claim 32), or that content is classified by past consumption by users as a consequence of ads that were received and responded to by them (claim 36). The Examiner states that these approaches are “old and

well known in the computer related arts,” and that it would have been obvious for a person of ordinary skill in the art to have combined Emens, Herz, and the Examiner’s statement of what is “old and well known” at the time of the invention to achieve the invention of claims 32 and 36.

First, the Examiner’s statement that it is “old and well known . . . to monitor the amount of click through of an ad,” and that it is “old and well known to classify information related to past consumption of prior products or coupons redemption by the consumer . . .” is not supported by any “concrete evidence in the record . . .” (*See* MPEP § 2144.03(c), *citing In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001)). Accordingly, Applicants request that the Examiner support this personal knowledge with affidavits containing data as specific as possible pursuant to 37 C.F.R. §1.104(d)(2). Without supporting evidence, the Examiner has impermissibly relied on personal knowledge and, thus, has not established a *prima facie* case of obviousness. The Examiner has not provided any affidavits in support of this personal knowledge.

In the final Office Action of February 25, the Examiner suggests, with reference to MPEP § 2144.03 and *In re Boon* that Applicants’ challenge to the Examiner’s statement must “at least cast reasonable doubt on the fact taken notice of.” Applicants find no reference to *In re Boon* or to this standard in MPEP § 2144.03

Therefore, Applicants respectfully request that the rejection of claims 15, 16, 21, 22, 27 – 36 and 37 – 89 under 35 U.S.C. § 103(a) be withdrawn.

**CONCLUSION**

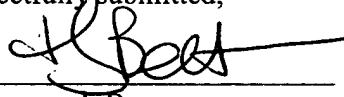
In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

The Examiner is respectfully requested to contact the undersigned at the telephone number indicated below if the Examiner believes any issue can be resolved through either a Supplemental Response of an Examiner's Amendment. In view of the above amendment, Applicant believes the pending application is in condition for allowance.

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Respectfully submitted,

By



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